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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,216	12/22/1999	DALE F. MCINTYRE	80121F-P	5901

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PATENT LEGAL STAFF
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EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 01/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/470,216

Applicant(s)

MCINTYRE ET AL.

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

2. Claim 9 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Dependent Claim 9 is referring to itself. Please make appropriate correction.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 9 recites the limitation "said goods or service" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-17, 20, 24-33, 44-52, and 62-76 are rejected under U.S.C. 35 102 (e) as being anticipated by Shiota et al, patent number 6,324,521.

As per Claims 1-17, 20, 24-33, 44-52, and 62-76, Shiota et al teaches a system and method of providing customers with a photographic service via a network, disclosing a fulfillment center that manages customer orders and images, minilabs, special laboratories, and customers connected remotely via the Internet for viewing and ordering images (see at least abstract; Fig. 1 (1, 2, 3, 4, 5); Fig. 6 (36); col. 1, lines 54-67; col. 2, lines 1-9; col. 2, lines 56-67; col. 7, lines 58-62). Shiota et al teaches image retaining devices such as one or more rolls of photographic film that is electronically scanned and converted into digital images

(see at least Fig. 1 (7); col. 2, lines 33-41), the storing of digital images in databases (see at least Fig. 6 (33, 34, 38, 40); col. 10, lines 65-67; col. 11, lines 1-12), and automatically providing a product after reaching a predetermined criteria of time (see at least col. 4, lines 34-36; col. 8, lines 41-43) or number of images. Registration information for an order comprises a reception number unique to the order, a processing number unique to the service requested for the images being supplied, and a plurality of image numbers, or image identification (ID) numbers, each being unique to the associated digital image (see at least Fig. 2; col. 3, lines 31-35). Shiota et al teaches the use of a web browser plug-in to facilitate browsing and image viewing, and processing application software to manipulate images prior to ordering goods or service. Shiota et al teaches service and goods such as outputting prints, extra prints, picture postcard, compact disc (CD) (see at least Fig. 6 (11); col. 10, lines 54-58), the passing of ID numbers between customer, manufacturer, and processors, and arrangements or images in an album (see at least col. 4, lines 28-42).

Shiota et al further teaches ordering information comprising one or more formats (see at least Figs. 2; col. 6, lines 46), of which the format in Fig. 2 discloses a reception number that is used as a registration number for an image retaining device, each image retaining device number comprising at least one image identified by an image number. Shiota et al further discloses an hierarchical approach to order information processing (see at least Fig. 3; col. 6, line 47) where in Fig. 3 Order Information 1 represents ordering information for

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the first image retaining device, Order Information 2 represents the ordering information of the second image retaining device, and etc., whereby the print order file comprises a group or subgroups associated with a print order.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 18, 19, 21-23, 34-43, and 53-61 are rejected under U.S.C. 35 103(a) as being unpatentable over Shiota et al, in view of Nakagoshi, patent number 5,020,669, and in further view of Egan, patent number 6,273,986.

As per Claims 18, 19, 21-23, 34-43, and 53-61, Shiota et al teaches all the claims above but fails to disclose a plurality of image retaining devices in a package. Nakagoshi teaches a plurality of image retaining devices comprising photographic film in a package, and the use of a bar code printed on the package for identification purposes (see at least Fig. 1 (7); Fig. 2 (10); col.2, lines 61-65). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the systems and methods of Shiota to include multiple image retaining devices in a single package with a package identification number

as taught by Nakagoshi, in order to better accommodate consumer needs for more than one role of film per photographic session.

Shiota et al and Nakagoshi teach image ID, single retaining device ID, a plurality of image retaining devices in a package, and package ID but do not disclose a registration number or identification number that can be used to register all image retaining devices in a package, nor discloses a peelable label that serves as a packing slip for the package. Egan teaches composite labels, package labeling systems and methods where the composite label serves as a combination of shipping label and packing list label with the shipping bar code indicia or other suitable indicia used for tracking purposes and identifying the contents of the package noted on the packing list (see at least abstract; col. 2, lines 32-36; col. 4, lines 18-22). The user removes the shipping label to reveal the packing list that identifies package contents (see at least col. 3, lines 22-51). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Shiota et al and Nakagoshi to incorporate a peelable package label, shipping and packing slip indicia as taught by Egan, in order to provide a single identification number associated with the plurality of image retaining device IDs contained in the package.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:


- US 6,324,545 (Morag) 27 November 2001; teaches organizing digital images scanned from photographic film or obtained directly from a digital camera, criteria for ordering goods and service, and image indexing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:00AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

RMP
December 31, 2001


WYNN COGGINS
SUPERVISORY PATENT EXAMINER
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